

REPLY BRIEF
EXAMINING GROUP 3738
Patent Application
Docket No. GJE-7134
Serial No. 10/633,209

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner : William H. Matthews
Art Unit : 3738
Applicant : Peter Toop
Serial No. : 10/633,209
Filed : July 31, 2003
Conf. No. : 3280
For : Intraocular Lens

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Commissioner for Patents
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REPLY TO EXAMINER'S ANSWER

I hereby certify that this correspondence is being
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June 9, 2008

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Reply to Examiner's Answer

This is in response to the Examiner's Answer (hereinafter, "the Answer") dated April 7, 2008.

With regard to Sections (1) through (8) of the Answer, no areas of disagreement between the Appellant and the Patent Office are evident.

With regard to Section (9) of the Answer, the ground of rejection is essentially a re-iteration of the rejection set forth in the Final Rejection. The Appellant has addressed this ground of rejection in the Appeal Brief.

With regard to Section (10) of the Answer, in which the Answer responds to the Appellant's arguments, the Appellant notes what appear to be new issues.

Below, the Appellant addresses the new issues raised in the Answer's "Response to Argument" section.

A. The Answer asserts that Blake discloses a lens designed for use in the capsular bag of the posterior chamber.

The Answer cites three sections of Blake (col. 4, lines 50-54; col. 5, lines 9-16; and col. 11, line 65 through col. 12, line 3) and avers that the lens is designed for use in the capsular bag of the posterior chamber. The Appellant respectfully disagrees. Blake makes it abundantly clear throughout the reference that its lens is intended for use in the anterior chamber angle of the eye. No discussion or example is given of a lens in use in the posterior chamber or of a method for using a lens in the posterior chamber. Certainly, there is no disclosure or example of a lens in use in the capsular sac.

Regarding the portions of Blake cited by the Answer; at column 5, lines 9-16, Blake discusses how a standardized procedure for implanting an intraocular lens might be performed. It is clear that this section contains a general discussion of the anatomy of the eye and existing intraocular lenses. This sole reference to the capsular sac is not teaching how the Blake lens can be implanted but rather how an existing lens might be used in a standardized procedure.

Additionally, at column 4, lines 50-54 and at column 11, line 65 through column 12, line 3, Blake briefly mentions the possibility of using its lens in the posterior chamber, but does not discuss the capsular sac. In each case, Blake teaches that the anterior chamber is the location for

which the lens is designed, disclosing that the lens is “especially suited for use in the anterior chamber” (col. 4, lines 52-53). Additionally, when Blake mentions the posterior chamber at column 12, it is only to say that it can be “envisioned that the lens could also be implanted in the posterior chamber” (col. 12, lines 1-3; emphasis added). It is clear that the Blake lens had not actually been used in the posterior chamber, certainly not in the capsular bag of the posterior chamber, and that it was not intended to be.

As the Appellant noted in the Appeal Brief, a skilled artisan would readily recognize that, if the intraocular lens of Blake were to be placed in the capsular sac, the contractions of the capsular sac would cause haptic failure of the Blake lens, leading to twisting and buckling of the haptics (see second paragraph of page 4 of the Appeal Brief). Therefore, one of ordinary skill in the art, starting with the Toop lens clearly intended for placement in the capsular sac, would not have had a reason to turn to Blake, which teaches a lens that is designed for the anterior chamber.

Furthermore, the Answer states that a reasonable expectation of success existed for the combination of Toop and Blake based on the cited portions of Blake outlined above. Once again, the Appellant respectfully disagrees. Even though Blake briefly mentioned that it is “envisioned” that its lens “could” be used in the posterior chamber, there is still no disclosure of using the Blake lens in the capsular sac of the posterior chamber. Also, as discussed above, a skilled artisan would recognize that the Blake lens could not be placed in the capsular sac without haptic failure, leading to twisting and buckling of the haptics.

Thus, one of ordinary skill in the art would not have had a reasonable expectation of success in combining the Blake lens with the Toop lens.

B. The Answer asserts that Blake discloses advantages to provide a thicker haptic part on the Toop lens.

The Answer cites several portions of Blake for the proposition that Blake discloses advantages for using a haptic with a thicker distal region (cited portions: col. 8, lines 48-58; col. 4, lines 63-65; col. 4, lines 58-61; col. 9, lines 65-67; col. 5, lines 43-50; and the abstract). However, in each of these sections, the alleged advantages are for the use of an elastomer in the haptic. As discussed at page 3 of the Appeal Brief, the fact that the haptic using an elastomer may have a thicker distal region is an incidental effect. Not once in the entire Blake reference is a single advantage given for making the distal region of the haptic thicker.

Despite the portions cited by the Answer, a skilled artisan would not have found an advantage disclosed for making the distal region of a haptic thicker. Instead, the cited portions would have only motivated a skilled artisan to use an elastomer in the haptic of an intraocular lens designed for use in the anterior chamber.

Thus, there is still no reason given why one of ordinary skill in the art would combine Toop and Blake to arrive at the claimed invention. Accordingly, the Appellant respectfully maintains that a *prima facie* case of obviousness has not been produced by the Examiner.

In view of the foregoing, the appellants urge the Board to reverse the outstanding rejection under 35 U.S.C. §103(a) and pass this application to issuance.

Respectfully submitted,

A handwritten signature in black ink, reading "David Saliwanchik". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

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